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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,397	03/01/2002	Sabine Bub	38485-0006	4269

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/914,397

Applicant(s)

BUB ET AL.

Examiner

David A. Lambertson

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 11 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1, 2, 5, 6 and 8-13.

Claim(s) objected to: 4.

Claim(s) rejected: 3 and 7.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Specifically, applicant has amended claims 3-5 and 7 in order to overcome rejections under 35 USC 112, second paragraph. However, in doing so, applicant has introduced new terms that raise new issues, thereby requiring a new search and new consideration. Specifically, claims 3-5 add limitations that had not previously been considered (i.e., "a hybridizing sequence comprising a detectable element is bound to the SK primer" in claim 3; "comprises two SK primer sequence elements" in claim 4; "modified at their end with a detectable element" in claim 5). These new limitations require new consideration because they raise questions regarding their suitability to define the invention. Furthermore, claim 7 amends step (b) such that it represents an entirely different method step (i.e., adding "SK oligonucleotides comprising a marker") and eliminates a method step, thereby broadening the scope of the invention. This broadening in the scope of the invention complicates the issues rather than simplifying them for purposes of appeal. Because the amendments to the claims raise new issues requiring a new search and new consideration, and because prosecution on the merits is closed, the After Final Amendment has not been entered.

Continuation of 5. does NOT place the application in condition for allowance because: the amendments to the claims do not simplify the issues for purposes of appeal. The new limitations to the claims do not necessarily make the claims more definite, and the amendment to claim 7 specifically broadens the scope of the claimed invention, thereby complicating the matter for purposes of appeal.


DAVID GUZO
PRIMARY EXAMINER